REMARKS/ARGUMENTS

The Applicants respectfully request reconsideration of the present application in light of the amendments made to the application and the following remarks, which are responsive to the Office Action mailed October 19, 2004. Claims 33-66 are pending in the application.

The Applicants will respond to the Official Action in the general order in which it was presented.

A. Double Patenting Rejection

The Examiner rejected claims 33-64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,634,551 (hereinafter "the '551 patent"). Applicants have amended the specification to clarify that the current application is a continuation of and claims priority from the '551 patent. In addition, Applicants respectfully submit a terminal disclaimer pursuant to MPEP § 804.02 and 37 CFR 1.130(b) in order to obviate the double patenting rejection. The terminal disclaimer can be found in the Appendix at the end of this response.

B. Drawing Objection

The Examiner objects to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5) because reference number **800** is mentioned in the specification (page 5 line 12 and page 15 lines 9 and 12), but is not shown in Figure 8. The Examiner also submits that Figure 4 contains the reference number **401** but there is no reference number **401** in the specification. The Examiner states "[a] proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of this application. The objection to the drawings will not be held in abeyance."

Applicants propose to correct Figure 8 by submitting a substitute drawing in accordance with 37 C.F.R. § 1.85(c) to replace the originally filed Figure 8. The proposed substitute

drawing will include reference number **800** referring to the entire process shown in Figure 8. Applicants propose to correct Figure 4 by submitting a substitute drawing in accordance with 37 C.F.R. § 1.85(c) to replace the originally filed Figure 4. The proposed substitute drawing will not include reference number **401**.

Applicants respectfully request that the Examiner approve of the new amended formal drawings contained in the Appendix at the end of this response.

C. Specification Objection

The Examiner objected to the specification because of several informalities. As may be seen, the Applicants have requested that the paragraph on page 11 lines 6 through 14 be amended. These amendments are as follows. At page 11, line 10 of the specification, Applicants have deleted **70** and replaced it with --**20**--. At page 11, line 12 of the specification, Applicants have deleted **71** and replaced it with --**21**--.

D. Claim Objections

The Examiner objected to the Claim 40 based on an informality. As may be seen, the Applicants have amended Claim 40 to replace "A)" with "E)" as requested by the Examiner.

E. Claim Rejections – 35 U.S.C. § 103 – Claims 33-35, 37, 39-46, 48, 50-52, 54-55, 57, 59-62, and 64-66

1. The Examiner's Rejection

In the Official Action, claims 33-35, 37, 39-46, 48, 50-52, 54-55, 57, 59-62, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Monico* (U.S. Patent No. 6,021,942) in view of *Gulick* (U.S. Patent No. 5,362,949).

The Examiner submits in part that:

> **"In view of the teaching of Gulick, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the barcode condensing system of Gulick to the package delivery service of Monico because having one barcode that can access information for a plurality of items is favorable because in this way the plurality of delivery notices will not be misplaced and the labor intensive shipping labels can be avoided. In addition, the information will be stored in a centralized database that will keep all of the information together. It is appropriate to combine these references because in combination they teach the invention of linking the plurality of delivery notices together, wherein Monico teaches the scanning and storing of the delivery codes and Gulick teaches the condensing of identifying information into one barcode."**

2.   The *Monico* Reference

The invention disclosed in *Monico* is directed toward a three-part delivery notice having a first section, a second section and a third section. The third section is a first delivery attempt notice, the second section is a second delivery attempt notice, and the first section indicates a reason for delivery failure (reference FIG. 1 of the patent). Each portion of the three-part delivery notice in *Monico* has machine-readable and human-readable indicia. Unlike the present invention, common indicia are used on each section of the delivery notice in *Monico*. *Monico* reads as follows at column 5, lines 1-42:

> "The **first section** 21 typically includes identification indicia shown generally by reference 33 in FIG. 1, and including a machine-readable (e.g. bar code) part 34, and a human-readable part 35. The first section 21 also comprises a plurality of (at least two, and preferably at least three) reason for non-delivery indicia. These indicia all include a machine-readable (e.g. bar code) part 36 and a corresponding human-readable part 37. The particular reason for non-delivery indicia illustrated in FIG. 1 include "wrong address", "consignee moved", "consignee not at home", "office closed", "damaged", "refused delivery", "not delivered (no time)", "wrong route", and "other". The "other" indicia is followed by lines 38 facilitating the entry of handwritten information. The above reasons for non-delivery are exemplary only and different or other wording and/or reasons may be provided. The **third section** 23, which may be connected directly to the first section 21 if the second section 22 is not provided, preferably **includes indicia 133 in common with the indicia 33 (except having an extender**

indicating the first attempt at delivery). This includes a machine-readable part 134 and a human-readable part 135, with the extenders 40, 41. The indicia imaged on the third section 23 also preferably includes human-readable indicia 42 (e.g. "first attempt") indicating a first attempt to deliver a package, and preferably also includes a toll-free telephone number indicia 43 to call if an indicated redelivery time is inconvenient, to request redelivery, and/or for questions, and one or more blank areas 44 for the entry of handwritten indicia indicating potential other delivery dates or times. Also there may be indicia 45 indicating that if the addressee/consignee would like the package merely left at the door that he or she can sign at the indicia 46 and on the next delivery the package will merely be left at the door. Other suitable indicia also may be provided, as illustrated in the example in FIG. 1.

The **second section 22 also includes identification indicia 233, but with a different extender 240, 241, the indicia 233 – except for the extender – in common with the indicia 33, 133.**" (Emphasis in boldface type added.)

Therefore, *Monico* only teaches that the identification indicia (e.g., barcode) on the first, second and third sections of the label are common, except for the extender used to identify the second and third sections. The extender is used to identify whether the delivery attempt is a first delivery attempt or a second delivery attempt. When a first attempted delivery is unsuccessful, the identification indicia on the first section is scanned as well as a barcoded reason for non-delivery. One section (section three) of the three-part delivery notice is separated from the three-part notice and is left at the addressee's location. The remaining sections are affixed to the package. The common identification indicia with its extender on the section of the label that is left at the addressee's location may be scanned to determine whether the delivery attempt was a first or second delivery attempt. The second section of the label may be left at the delivery location if another unsuccessful delivery attempt occurs. Note that the identification indicia (e.g., bar-code) on all three sections of the *Monico* delivery notice are <u>common</u> identification indicia.

Stated simply, there can be *two* delivery notices each bearing the *same* indicia left at an addressee's location for the *same* package.

In contrast, Applicants' invention discloses that a **single** delivery notice with a delivery notice code can be linked to a **plurality** of packages with each package having a **different**

package code thereon. In one preferred embodiment, the package code is a "tracking number" used by commercial delivery services for tracking parcels. Each package code is unique:

> "As shown in Fig. 2, the exemplary package **110** includes a machine-readable package code **111** (a.k.a. "item code"), which in one embodiment is a "tracking number" or "1Z" number as referenced by United Parcel Service, although obviously other package codes used to track or identify packages may also be used. (Applicants' specification, page 7, lines 33-35; page 8, line 1.)

And:

> "It will be assumed that two parcels **110, 120,** are to be delivered, with each parcel including a different machine-readable parcel code (a.k.a. "item code") readable therefrom. (Applicants' specification, Page 9, lines 24 – 26.)"

As will be discussed further below, in the present invention, the package code is not "affixed" on a package by an adhesive as a section or sections of a multi-section form, as is taught by *Monico*, nor is the package code "common" with the delivery notice code. In contrast, in the Applicants' invention, the delivery notice code is "linked" to the package codes of a plurality of packages.

3.   The *Gulick* Reference

The Examiner submits that "[r]egarding claims **33-35, 37, 39-46, 48, 50-52, 54-55, 57, 59-62, and 64-66** *Monico* **fails to teach that there are a plurality of items linked together in a single barcode on one notice**" and cites *Gulick* to form an obviousness-based rejection.

Gulick teaches a packing house control system. Specifically, *Gulick* discloses the use of a single machine-readable label (e.g. barcode) to represent multiple items of information rather than using a separate machine-readable label for each item of information. *Gulick* teaches the association of multiple items of information to one barcode label. *Gulick* discloses that:

> "In the prior art, when up to three or four labels with various codes are placed on the carton, there is always the chance that the carton may be removed from the conveyor line prior to reaching the scanning device, thereby losing all track of the packed carton.

> In this invention, the packed boxes, **bearing one coded label**, pass from the packing unit 10 on a conveyor 14 to a scanner reading station 16." (Col. 5, lines 48-55, emphasis in boldface type added.)

And, that:

> "In the prior art as known at this time, more than one code label must be placed on each box in order to guide the box through the system and provide information concerning the box." (Col. 6, lines 24-27.)

Therefore, unlike the Applicants' invention, it can be seen that *Gulick* teaches the combination of separate information items that in the prior art were each associated with their own barcode into a single barcode reflective of the aggregated information. *Gulick* does not teach linking one barcode to a plurality of different barcodes.

4.   Applicants' Response

Claim 33 of the Application is reproduced below for clarity and reference in the following discussion:

33.   A system for delivering a **plurality of unique items** each having **unique identities** and each having a **different machine-readable item code readable therefrom**, said system comprising;

A) a delivery notice having a machine-readable delivery notice code thereon;

B) a code-reading device configured to **read said machine-readable delivery notice code from said delivery notice as well as to read said machine-readable item code from each of said plurality of items**, such that a delivery notice code is read and a plurality of item codes are read; and

C) a code storing device, said device configured to store said delivery notice code and said plurality of item codes.

The Applicants' invention materially differs from *Monico* in several aspects. In *Monico* there is no need to link the identification indicia on the section that is left at the addressee's location (i.e., delivery notice) with the identification indicia on the sections that are affixed to the package (i.e., package code) because each section has common identification indicia. Applicants' invention discloses the linking of a unique delivery notice code with a plurality of package codes.

Referencing Claim 33, above, an element of the claim requires reading the machine-readable delivery notice code **and** the machine-readable item codes. If the delivery notice code and the item code were in common, as in *Monico*, there would be no need to read both codes. There is no requirement for commonality between the delivery notice code and the package codes in the Applicants' invention. Applicants' use of a delivery notice code that is not common with the package codes of a plurality of packages allows each package in such plurality to be separately identified, tracked and manipulated. Furthermore, unlike the Applicants' invention, *Monico* teaches affixing a portion of the delivery notice to the package to provide a machine-readable indicia on the package. The Applicants' invention utilizes pre-existing package codes used to track or identify the package.

The Examiner states, "*Monico* **teaches a bar-coded label for 'attempt to deliver' parcels**." This itself is true, but the Applicants are not claiming the general use of bar codes with "attempt to deliver" parcels.

Applicants respectfully submit that *Monico* teaches a multi-section bar-coded label for "attempt to deliver" parcels having a common bar-code on all sections of the label with one section left at the addressee's location as a delivery notice and the remaining sections affixed to the package. *Monico* fails to teach or suggest a unique delivery notice code on a delivery notice linked with tracking numbers (package codes) on a plurality of packages wherein the delivery notice code and the tracking numbers are not common.

Applicants respectfully submit that *Gulick* teaches the combination of separate information items that in the prior art were each associated with their own barcode into a single barcode reflective of the aggregated information. Significantly different than *Gulick*, the Applicants' invention links one bar code (the delivery notice code) to a plurality of bar codes

(the package codes). Claim 33 of the Applicants' Application requires reading a machine-readable delivery notice code from one of said delivery notices and reading a machine-readable item code from each of said plurality of items, such that a delivery notice code is read and a plurality of item codes are read. The present invention is not directed toward the consolidation of barcodes or the consolidation of information represented by a multitude of barcodes into information represented by only one barcode as is found in *Gulick*.

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify *Monico* in view of the teaching of *Gulick* to arrive at the Applicants' invention. The Examiner submits, "**[i]t is appropriate to combine these references because in combination they teach the invention of linking the plurality of delivery notices together, wherein *Monico* teaches the scanning and storing of the delivery codes and *Gulick* teaches the condensing of identifying information into one barcode.**" However, the present invention links one delivery notice to a plurality of items, it does not link a "plurality of delivery notices together." Furthermore, the present invention links the barcode left on a single delivery notice to unique barcodes on a plurality of items. It does not require fewer or consolidate barcodes. In fact, it requires additional barcodes because the pre-existing barcodes on packages used for tracking purposes are linked to another different barcode on a delivery notice. The link is between the barcode of the delivery notice and the unique barcodes of the items, it is not a means of "condensing identifying information into one barcode."

Therefore, it is respectfully submitted that *Monico* and *Gulick*, separately or in combination, do not teach or suggest the present invention. Moreover, because *Monico* teaches the use of one common barcode on the delivery notice and the package, and *Gulick* teaches consolidating a multitude of barcodes into one barcode, there is no suggestion to modify *Monico* in view of *Gulick* and it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify *Monico* in view of *Gulick*.

Accordingly, Applicants respectfully submit that independent Claims 33-35, 37, 39, 41, 45-46, 48, 52, 55, 57, 60, and 65-66, and their respective dependent claims (namely claims 40, 42-44, 50-51, 54, 59, 61-62, and 64) are all patentable, each on its own merits, over the combination of *Monico* and *Gulick*. Claims 33–35, 37, 39 and 41 are all system claims directed

toward a system for delivering a plurality of unique items each having *unique identities* and each having a *different* machine-readable item code thereon and a delivery notice with a machine-readable delivery notice code thereon. As set forth above, it is respectfully submitted that the combination of *Monico* and *Gulick* does not suggest such a system and these claims are allowable. Claims 40 and 42-44 depend from these allowable independent claims and thus, are likewise submitted to be allowable on their own merits.

Claims 45-46, 48, 52, 55, 57, 60, and 65-66 are method claims directed toward a method for delivering a plurality of unique items each having *unique identities* and each having a *different* machine-readable item code thereon and a delivery notice with a machine-readable delivery notice code thereon. Again, as set forth above, it is respectfully submitted that the combination of *Monico* and *Gulick* does not suggest such a method and these claims are allowable. Claims 50-51, 54, 59, 61-62, and 64 depend from these allowable independent claims and are also submitted to be allowable on their own merits.

F. Claim Rejections – 35 U.S.C. § 103 – Claims 36, 38, 47, 49, 53, 56, 58, and 63

1. The Examiner's Rejection

In the Official Action, Claims 36, 38, 47, 49, 53, 56, 58, and 63 (all dependent claims) are rejected under 35 U.S.C. 103(a) as being unpatentable over *Monico* as modified by *Gulick* and further in view of *Knowles et al.* (U.S. Patent No. 5,869,819, hereinafter "*Knowles*"). The teachings of *Monico* as modified by *Gulick* have been discussed above.

The Examiner submits in part that:

> "In view of the teaching of Knowles, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an internet connection for transmitting data because it is well known in the art that the internet is a reliable, convenient, and safe way to transmit data."

2.   The *Knowles* Reference

Knowles discloses in its Abstract:

"A novel Web-based package routing, tracking and delivering system and method that uses URL/ZIP-CODE encoded bar code symbols on parcels and packages. The system comprises one or more Routing, Tracking and Delivery (RTD) Internet Server Subsystems connected to the Internet infrastructure and updated at any instant of time with package tracking information. A Package Log-In/Shipping Subsystem is located at each shipping location and connected to the RTD Internet Server by way of the Internet infrastructure. A Package Routing Subsystem is located at a hub station and connected to the RTD Internet Server by way of the Internet infrastructure. A Portable Package Delivery Subsystem is carried by each package delivery person, and connected to the RTD Internet Server by way of the Internet infrastructure communication link. At each remote hub station within the system, the URL/ZIP-CODE encoded bar code symbol is automatically scanned by way of the Internet infrastructure; the encoded destination Zip Code is locally recovered and used to route the package at the hub station; and the locally recovered URL is used to access the RTD Internet Server and update the location of the package within the system. The Portable Package Delivery Subsystem is used to read the URL/ZIP-CODE encoded bar code symbol near the delivery destination in order to access the RTD Internet Server and display delivery information and the like to facilitate the delivery process."

Applicants respectfully submit that generally, *Knowles* discloses systems and methods for package-tracking that utilize a specialized bar-code that includes an Internet uniform resource locator ("URL"). Each parcel or package has an Internet website established such that the package may be tracked by scanning the URL-encoded barcode at various locations throughout the delivery process and updating the package's website. Other information, such as delivery instructions may also be included on the website and may be accessed by a delivery person using a portable scanner with Internet access.

3.   Applicants' Response

The Examiner states that *Monico* as modified by *Gulick* fails to disclose that an Internet connection is used for receiving data and cites *Knowles* for that element. However, Applicants

respectfully submit that *Knowles* teaches an Internet-based system and method for tracking objects bearing URL/ZIP-encoded bar code symbols. The Examiner concedes that "*Knowles* teaches an internet-based system and method for tracking objects bearing URL-encoded bar code symbols."

As noted above, Applicants submit that neither *Monico* nor *Gulick*, separately or in combination, teach or suggest the present invention. Therefore, the addition of *Knowles* with its teaching of "an internet connection for transmitting data" adds little, if anything, in forming a combination that would have been obvious at the time of the invention. *Knowles* does not teach the transmission of information linking the machine-readable indicia of a delivery notice to machine-readable indicia on a plurality of packages ("item codes") as is disclosed in the Applicants' invention. The "item codes" of the present invention are tracking numbers (i.e., "1Z" numbers), not specialized URL/ZIP-encoded bar code symbols as is disclosed in the *Knowles* patent.

Furthermore, Claims 36, 38, 47, 49, 53, 56, 58, and 63 of the Application are dependent claims that depend from claims that are allowable based on the above argument concerning the *Monico – Gulick* combination. These dependent claims add the element of utilizing the Internet as a medium to access stored information about the linking of a delivery notice to a plurality of items and provide a means for re-directing one or more of the packages. It does not provide access to a specific URL regarding a particular parcel, as is taught in *Knowles*.

Therefore, Applicants respectfully submit that dependent claims 36, 38, 47, 49, 53, 56, 58, and 63 are patentable on their own merit over the combination of *Monico* and *Gulick* in view of *Knowles*.
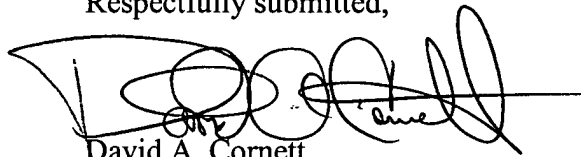

D. Conclusion

After this amendment, Claims 33-66 remain pending in this application with Claims 33-35, 37, 39, 41, 45-46, 48, 52, 55, 57, 60, and 65-66 being independent claims and claims 36, 38, 40, 42-44, 47, 49-51, 53-54, 56, 58-59, and 61-64 being dependent claims. Applicants respectfully submit that all pending claims are patentably distinguishable over the prior art of record, and therefore, are in condition for allowance.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

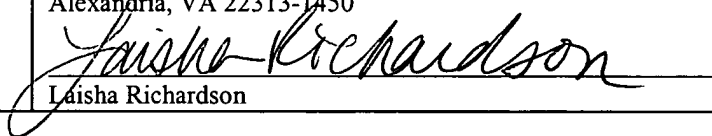Respectfully submitted,

David A. Cornett
Registration No. 48,417

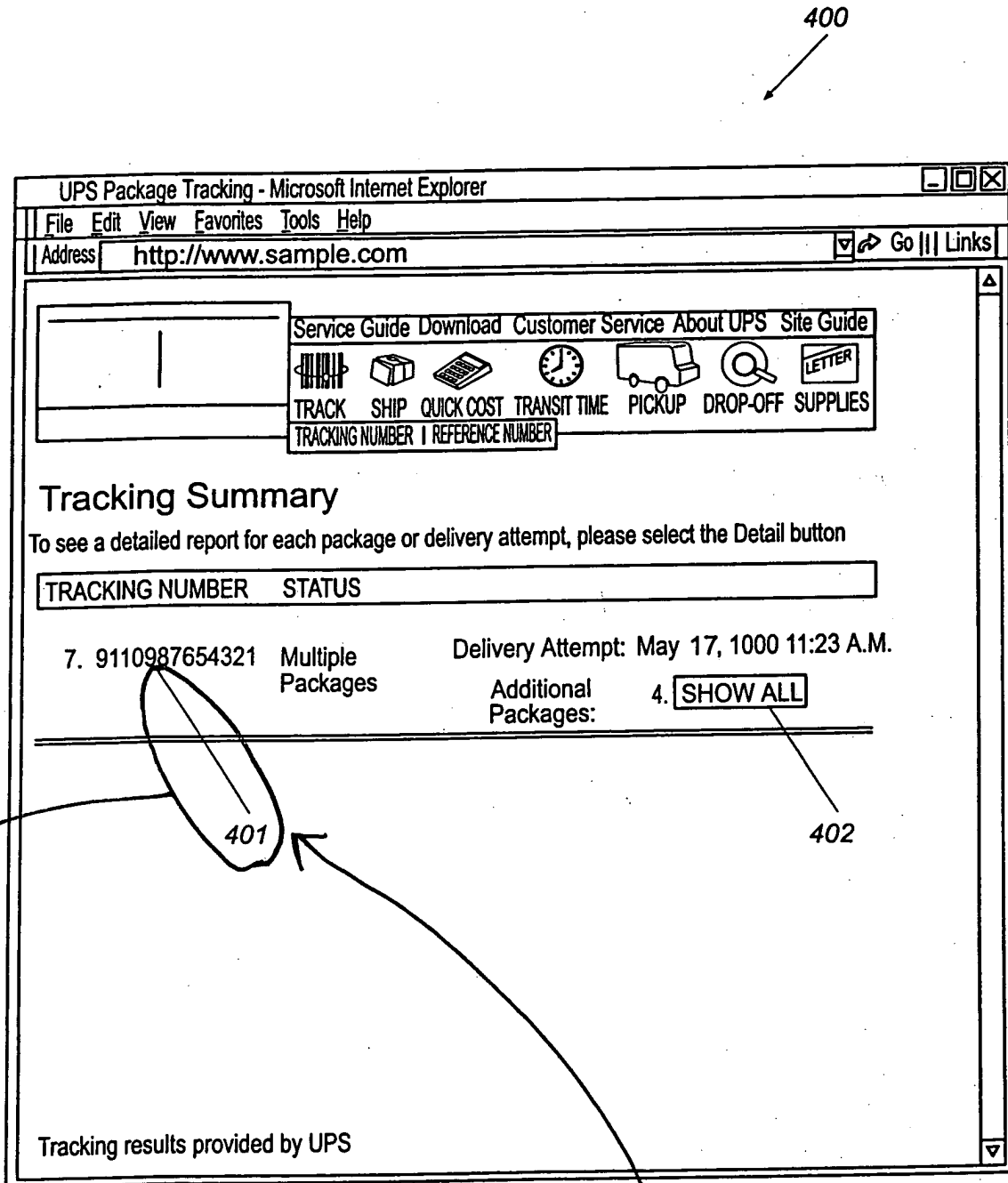| Customer No. 00826	"Express Mail" mailing label number EL 952 539 254 US
ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Atlanta Office (404) 881-7000 Fax Atlanta Office (404) 881-7777	Date of Deposit December 2, 2004 I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 Laisha Richardson

Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 4 and 8. These sheets, which include Figures 4 and 8, replace the original Figures 4 and 8. In the accompanying replacement sheets, reference number "**800**" has been added to Figure 8 referring to the entire process shown in Figure 8. In addition, reference number "**401**" has been removed from Figure 4.

Attachment: Replacement Sheets
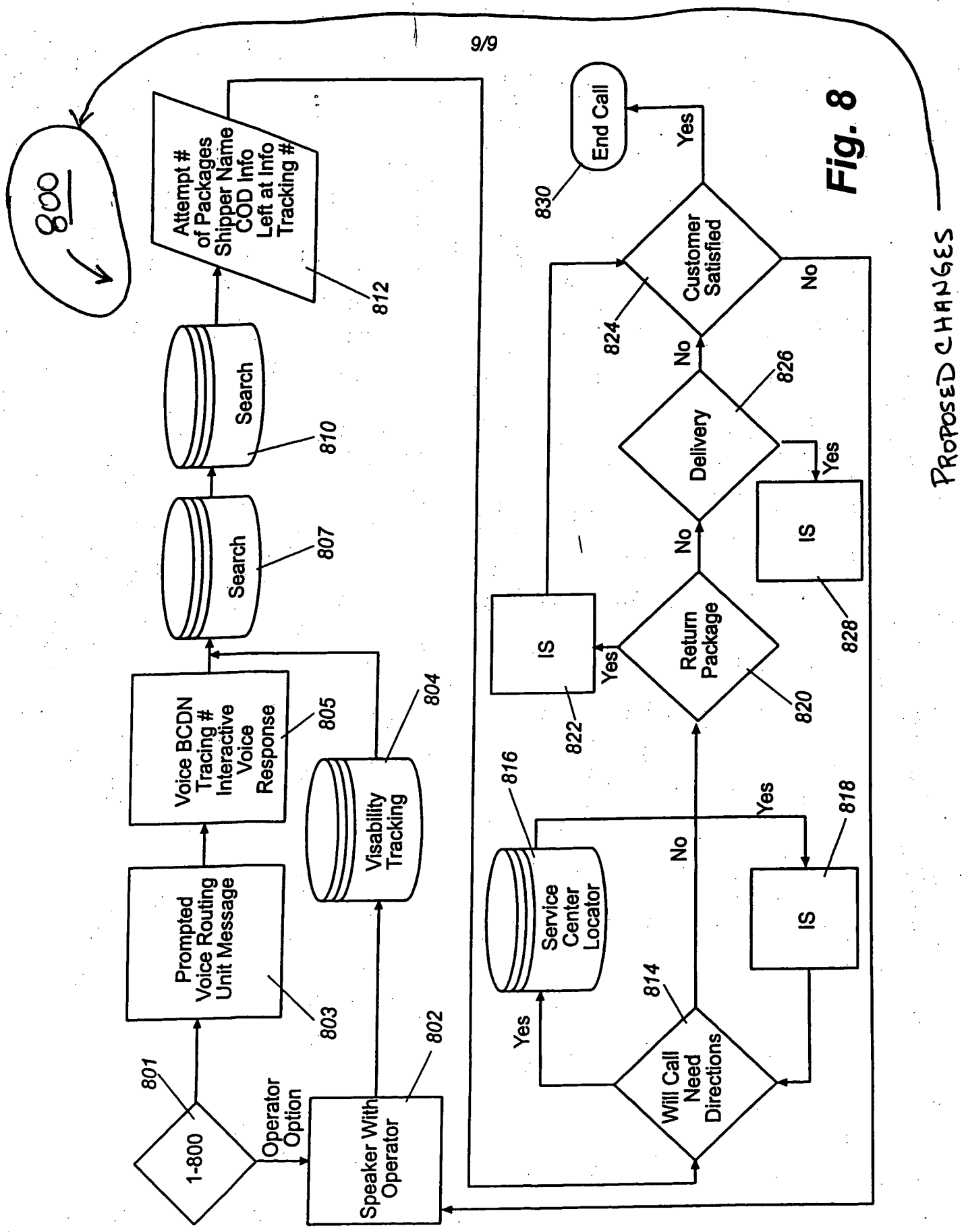
Annotated Sheets Showing Changes

Application No: 10/646,375
Amendment Dated: December 2, 2004
Reply to Office Action of October 19, 2004
ANNOTATED SHEET SHOWING CHANGES

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400

UPS Package Tracking - Microsoft Internet Explorer

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TRACK   SHIP   QUICK COST   TRANSIT TIME   PICKUP   DROP-OFF   SUPPLIES
TRACKING NUMBER I REFERENCE NUMBER

Tracking Summary

To see a detailed report for each package or delivery attempt, please select the Detail button

TRACKING NUMBER   STATUS

7. 9110987654321   Multiple   Delivery Attempt: May 17, 1000 11:23 A.M.
                   Packages
                                     Additional   4. SHOW ALL
                                     Packages:

401   402

Tracking results provided by UPS

InfoNotice Tracking Summary

Fig. 4

PROPOSED CHANGES

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ANNOTATED SHEET SHOWING CHANGES

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800

Fig. 8

PROPOSED CHANGES

1-800 — 801

Operator Option

Speaker With Operator — 802

Prompted Voice Routing Unit Message — 803

Visability Tracking — 804

Voice BCDN Tracing # Interactive Voice Response — 805

Search — 807

Search — 810

Attempt # of Packages Shipper Name COD Info Left at Info Tracking # — 812

Will Call Need Directions — 814

Service Center Locator — 816

IS — 818

IS — 822

Return Package — 820

IS — 828

Delivery — 826

IS — 824

Customer Satisfied

End Call — 830

Yes / No